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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,688	09/30/2003	David J. Park	66329/31349	6172
23380	7590	01/15/2009	EXAMINER	
TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414				ROBINSON, MYLES D
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE			DELIVERY MODE	
01/15/2009			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/675,688	PARK ET AL.	
	Examiner	Art Unit	
	Myles D. Robinson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 October 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 - 4, 6 - 12 and 14 - 16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 - 4, 6 - 12 and 14 - 16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 22 May 2008 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/2008 has been entered.

Response to Amendment

2. Applicant's amendment was received on 10/24/2008, and has been entered and made of record. Currently, **claims 1 – 3, 6 – 11 and 14 – 16** are pending.

3. Regarding **claims 1 and 8** in application of prior art, claim elements that are modified by sufficient structure, material, or acts for achieving the specified function will not be considered to invoke 35 U.S.C. §112, sixth paragraph because these elements fail to meet the first prong of analysis. If Applicant wishes to have the claim limitation treated under 35 U.S.C. §112, sixth paragraph, Applicant must delete such modifying language from the claim limitation. See MPEP 2181 I.

Response to Arguments

4. Applicant's arguments (see *Remarks 10/24/2008 [page 7, line 25 – page 8, line 17] and Interview Summary 10/22/2008*) with respect to the rejections of **claims 1 – 3, 6 – 11 and 14 – 16** under 35 U.S.C. §102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **Mooney et al.** (U.S. Patent No. 6,980,331).

Specification

5. The amendment to the title was received on 10/24/2008. This amendment is acceptable.

Claim Rejections - 35 USC § 112

6. Regarding **claims 1 and 8** in application of prior art, claim elements that are modified by sufficient structure, material, or acts for achieving the specified function will not be considered to invoke 35 U.S.C. §112, sixth paragraph because these elements fail to meet the first prong of analysis. If Applicant wishes to have the claim limitation treated under 35 U.S.C. §112, sixth paragraph, Applicant must delete such modifying language from the claim limitation. See MPEP 2181 I.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 1 – 3, 6 – 11 and 14 – 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **McGraw** (U.S. Patent No. 6,542,261) in view of **Mooney et al.** (U.S. Patent No. 6,980,331).

Referring to **claim 1**, McGraw discloses a system for processing of electronic documents comprising:

image generating means (see *Fig. 1, multifunction printer/FAX machine 12*) for generating an electronic representation of a paper document (see *Fig. 1, document 28 [column 2, lines 53 – 55 and column 3, lines 33 – 45 and 49 – 52]*),

the image generating means including means for receiving an associated tangible template sheet (see *Fig. 3 wherein the control form [e.g. cover sheet] is analogous to a tangible template sheet inclusive of a plurality of indicia [i.e. checkboxes] corresponding to instructions [column 5, lines 52 – 56 and column 6, lines 22 – 24]*) inclusive of a plurality of handwritten indicia (see *Fig. 3 wherein the Note section comprises handwritten characters to be scanned [column 5, line 61]*) corresponding to an instruction for a desired document processing operation (see *Fig. 3 wherein the checkboxes within the sections Resolution [e.g. standard, fine], Copy/Scan Type [e.g. black/white, color, resolution modes such as draft, normal and best] and Copy Setting [e.g. copy size, quantity, collation] are analogous to desired document processing operations*) and an instruction specifying a selected electronic document format for the

electronic document (see *Fig. 3 wherein the checkboxes within the section Scan Setting [e.g. BMP file, JPG file, TIFF file] is analogous to selected electronic document formats*),₁

optical recognition means for recognition of the instructions (*column 5, lines 54 – 56, column 6, lines 18 – 20 and 22 – 24*),₁

means for generating an instruction signal in accordance with a recognized instructions (*column 5, lines 52 – 60, column 6, lines 18 – 20, 22 – 24, 39 – 46 and 57 – 62 wherein the system produces a secure FAX based upon the user's selections on the control form of Fig. 3*),₁

means for controlling operation of an associated document processing device on the electronic representation of the paper document in accordance with the instruction signal so as to generate an electronic document in the specified electronic document format (see *Fig. 6 wherein steps S20, S28 output the secured FAX document in accordance to the boxes checked [column 5, lines 52 – 60, column 6, lines 39 – 46 and 57 – 62]*),

means for generating an output document in accordance with the controlled operation (see *Fig. 6, steps S20, S28 [column 3, lines 1 – 6, column 6, lines 39 – 46 and 57 – 62]*), and

means for communicating the output document in the specified electronic document format (see *Fig. 1 wherein the scanned document 28 is transmitted via communication system 16 [column 3, lines 36 – 40]*) to a destination in accordance with the instruction signal (see *Fig. 3 wherein the section Fax Settings To: is analogous to a specified destination [column 5, lines 61 – 64]*)

but does not explicitly disclose the system further wherein the plurality of handwritten indicia corresponds to an instruction for a desired document processing operation including, e-mail transmission and facsimile transmission, characters indicative of a desired recipient for an electronic document, optical character recognition means for generating character data from the characters, means for generating a confirmation display in accordance with the character data, means for receiving confirmation input from an associated user in accordance with the confirmation display, means for generating an instruction signal in accordance with the received confirmation input, and means for communicating the output document in the specified electronic document format to a destination in accordance with the character data.

Mooney discloses the system wherein the plurality of handwritten indicia corresponds to an instruction for a desired document processing operation including, e-mail transmission and facsimile transmission, characters indicative of a desired recipient for an electronic document (see *Figs. 1 – 2 wherein the recipient's fax number is handwritten in the a predefined region of the page 120, detected, recognized and converted to textual information for electronic transmission [column 4, lines 40 – 44, 49 – 52 and 53 – 57] and likewise in Figs. 3A – 5 wherein a recipient's e-mail address and/or fax number is written in predefined areas 320 [Title, Abstract, column 7, lines 7 – 13, column 8, lines 12 – 18, 38 – 46 and column 8, line 63 – column 9, line 3]*), comprising:

optical character recognition means for generating character data from the characters (see *Fig. 2 for fax numbers in step 208 [Abstract, column 2, lines 57 – 61,*

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column 4, line 66 – column 5, line 3 and column 10, lines 10 – 11] and see Fig. 5 for e-mail addresses in step 508 [Abstract, column 2, lines 57 – 61, column 9, lines 28 – 32 and column 10, lines 10 – 11],

means for generating a confirmation display in accordance with the character data (see *Fig. 1 wherein fax machine 190 displays the detected, recognized and textually converted recipient's telephone number for confirmation by the user before the outgoing fax is made [column 5, lines 49 – 56]*),

means for receiving confirmation input from an associated user in accordance with the confirmation display (*Abstract and column 6, lines 46 – 52 wherein error processing may allow the user to erase and rewrite the recipient's fax number or e-mail address*),

means for generating an instruction signal in accordance with the received confirmation input (*Abstract and column 6, lines 46 – 52 wherein the user's final confirmation of the rewritten recipient's fax number or e-mail address before sending the message is analogous to the instruction signal in accordance with received confirmation input*), and

means for communicating the output document in the specified electronic document format to a destination in accordance with the character data (*Abstract, column 3, line 64 – column 4, line 3 and column 7, line 64 – column 8, line 3 wherein the message is either faxed or electronically mailed*).

McGraw and Mooney are combinable because they are from the same field of endeavor, being optical character recognition-assisted facsimile systems. At the time of

the invention, it would have been obvious to one of ordinary skill in the art to include displaying the recipient's fax number and/or e-mail address for confirmation prior to sending messages along with such facsimile systems. The suggestion/motivation for doing so would have been to prevent messages from being sent to the wrong destinations as well as easily saving confirmed fax numbers into speed dial for future use, as suggested by Mooney (*column 1, lines 29 – 52, column 2, lines 2 – 6 and column 6, lines 34 – 52*).

Referring to **claims 2 and 3**, McGraw discloses the system further comprising means for identifying a location of relevant markings on the template sheet,

wherein the means for identifying the location of relevant markings comprised as at least one of check boxes and fill-in boxes (*see Fig. 3 wherein the checkboxes are analogous to locations of relevant markings*).

Referring to **claim 6**, McGraw discloses the system further wherein the output document is communicated via at least one of electronic mail transmission, facsimile transmission, FTP transmission, HTML transmission, and optical image rendering on an associated display (*see Fig. 1 wherein communication system 16 and connection 18 work in conjunction as either a telephone system or internet communication system [column 3, lines 36 – 40]*).

Referring to **claim 7**, McGraw discloses the system further wherein the output document is communicated to at least one of an electronic mail server, a document management system, an image generating device, and an Internet server (*see Fig. 1 wherein communication system 16 and connection 18 work in conjunction as either a*

telephone system or internet communication system [column 3, lines 36 – 40] wherein such systems inherently include servers and see Fig. 1 wherein either computer 32 or multifunctional printer/FAX machine 30 produces the secure FAX [column 4, lines 32 – 36]).

Referring to **claim 8**, McGraw discloses the system further comprising verification means for verifying the desired document processing operation (see *Fig. 6, step S26 [column 5, lines 37 – 51 and column 6, lines 53 – 56]*).

Referring to **claims 9 – 11 and 14 – 16**, the rationale provided in the rejections of claims 1 – 3 and 6 – 8, respectively, are incorporated herein. In addition, the systems of claims 1 – 3 and 6 – 8 perform the methods of claims 9 – 11 and 14 – 16, respectively.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Imoto (U.S. Patent No. 6,275,612) discloses a character data input apparatus wherein handwritten data is inputted, detected and converted using OCR, and then displays a generated list of candidate characters based upon those handwritten data input for confirmation (see *Abstract and Figs. 1 and 4 – 6*).

Narayanaswamy (U.S. Patent No. 6,167,411) discloses an automatically advancing user interface for entering new data and editing entered data in data entry fields on a display screen using a universal handwriting capture widget (HCW) (see *Abstract and Figs. 1 – 5*).

Mooney et al. (European Patent No. 1 107 570) disclose automatically sending to an embedded fax/e-mail address.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
1/10/09

Art Unit: 2625

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625